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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/350,060 07/08/99 CHAPMAN

D W9443-02

EXAMINER

IM22/1026

AHMED, S

ART UNIT

PAPER NUMBER

1773

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DATE MAILED:

10/26/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/350,060

Applicant(s)

CHAPMAN, DAVID MONROE

Examiner

Sheeba Ahmed

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1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 September 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-30.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

1. The Applicants request for reconsideration submitted on September 24, 2001 has been fully considered but the arguments are not deemed persuasive.

Applicants traverse the rejection under Stokes in view of Alexander and argue that the polyvinyl acetate disclosed by Stokes is not necessarily a non-ionic latex. Furthermore, with regards to the Examiner's position that the use of any polyvinyl acetate would lead to equivalent results (the Rohm and Hass document submitted by the Applicants further establishes that all the disclosed polyvinyl acetates, ionic or non-ionic, are equivalents of each other), the Applicants direct the Examiner's attention to Example 5. However, the Examiner takes the position that the Comparative data given in Example 5 and Table 2 is not commensurate in scope with the claimed invention. Example 5 is directed to a specific kind of non-ionic latex polymers (core-shell latex) having a specific particles size and not to all non-ionic latex polymers. Applicants further assert that the colloidal silica disclosed by Alexander are not porous and direct the Examiner's attention to Column 3, lines 11-20 to support such an assertion. However, the Examiner disagrees with the Applicants interpretation and would like to point out that Column 3, lines 20-29 state that the *if* the silica particles are dense *then* nitrogen absorption within the particle is negligible and surface area determined by nitrogen absorption and direct observation are close in value. In this case, the difference may be as great as 20% thus indicating that the silica particles are porous.

Applicants traverse the rejection based on Abe and submit that again the disclosed silica is not porous. However, the Examiner would like to direct the Applicants

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attention to Page 3, lines 7-11 of Abe which specifically state that the cation-modified silica is made by the process disclosed by Alexander (which as pointed out above uses a porous silica).

With regards to the rejection under Koch, the Applicant state that Koch does not suggest obtaining high solids coating having highly porous pigments having porosities over 0.9 cc/g. However, the claims rejected under Koch do not require that the silica have porosity over 0.9 cc/g and hence such an argument is not persuasive.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (703)305-0594. The examiner can normally be reached on Mon-Fri 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703)308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-5408 for regular communications and (703)305-3599 for After Final communications.



Sheeba Ahmed
October 25, 2001



Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700